O.I.P.E JC10 OCT 01 2002 PATENT & TRADEMARK OFFICE

GP 1771

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Posa et al.

Serial No.: 09/470,452 Group No.: 1771

Filed: Dec. 22, 1999 Examiner: H. Vo

For: TAPE AND WRAPPING MATERIALS WITH EDGE-FINDING FEATURE

RECEIVED OCT 03 2002 TC 1700

RESPONSE TO OFFICE ACTION

Assistant Commissioner for Patents
Washington, D.C. 20231

Dear Sir:

In response to the Office Action mailed June 27, 2002, the claims of this application are once again being submitted in unamended form for reconsideration in view of the following remarks.

Initially, it is noted that although claims 9-19 pending in this application, the Examiner has only examined claims 9-17 as part of the most recent Office Action. Applicants respectfully request that claims 18 and 19 be considered in future actions.

Claims 9-17 stand rejected under 35 U.S.C. §103(a) over the "admitted prior art" of Figure 1 and page 5, lines 11-15 of the specification in view Hielman et al. ('194). According to the Examiner, "the admitted prior art discloses a conventional packing tape meeting all of the limitations of structure and chemistry of the claimed subject matter except an edge of the tape that becomes visibly apparent when the tape is cut or torn. This statement appears to Applicant to be self-contradictory. Given that Applicants' novel tape that includes an edge which becomes visibly apparent when cut or torn, such a material cannot possibly meet all of the limitations of structure *and* chemistry of the claimed subject matter.

The Hielman patent is directed to a closure incorporating an irreversible color change system,

GIFFORD, KRASS, GROH, SPRINKLE, ANDERSON & CITKOWSKI, P.C. 280 N. OLD WOODWARD AVENUE, STE. 400, BIRMINGHAM, MICHIGAN 48009-5394 (248) 647-6000

GIFFORD, KRASS, GROH, SPRINKLE, ANDERSON & CITKOWSKI, P.C. 280 N. OLD WOODWARD AVENUE, STE. 400, BIRMINGHAM, MICHIGAN 48009-5394 (248) 647-6000

the closure including a brittle layer 44 which fractures and in part delaminates to indicate tampering. "The brittle layer 44 is formed of a brittle resin and should be a thermal set material that has proper fracturing and adhesion properties in order to work properly." ('194 patent, column 3, lines 45-47).

According to the Examiner, "Hielman discloses a color change system including a brittle layer 44 formed of a 'flexible material' and being colored with a fluorescent die and a bonding layer 42 that bonds the brittle layer to the background coating 40 ..." (quotations added by Applicant). The Examiner's insertion of "flexible material" into the description of Hielman's brittle layer is unjustified and misleading. There is nothing flexible about the brittle layer of Hielman and, in fact, even with the slightest deformation (apparently of a few millimeters) the brittle layer of Hielman simply cracks up. This is entirely different from Applicants' disclosed backing layer, which may be composed of "plastic such as cellulose-based materials, vinyls, urethanes, polyesters, and the like now currently employed for both opaque and transparent tapes ..." (specification, lines 18-20). Moreover, the "adhesive" of Hielman is more like a hardening cement, preferably in the form of a varnish "bonding layer 42." ('194 patent, column 3, lines 38-44). Accordingly, the Examiner's statement that "the brittle layer of Hielman is simply analogous to the backing layer of the conventional tape whereas the bonding layer of Hielman is comparable to the adhesive layer," runs counter to accepted definitions and interpretation by anyone of skill in the art.

Based upon this defective reasoning, the Examiner states that "it would have been obvious to one having ordinary skill in the art at the time the invention is made to incorporate a fluorescent die into the backing layer of the conventional packing motivated by the desire to generate an irreversible color change at the edge of the tape when the backing layer fractures due to a mechanical action." This statement represents a hindsight analysis, and even if the proper standard were being applied, the result

GIFFORD, KRASS, GROH, SPRINKLE, ANDERSON & CITKOWSKI, P.C. 280 N. OLD WOODWARD AVENUE, STE. 400, BIRMINGHAM, MICHIGAN 48009-5394 (248) 647-6000

is insufficiently applicable to Applicants' invention. Given that the teachings of Hielman et al. include a brittle structure that cracks up or breaks apart as part of a tamper-evident container, there is no teaching whatsoever *from the prior art* to include such a mechanism into the backing layer of a "conventional tape." Even if such a modification were performed, the Examiner states that the edge of the tape generates an irreversible color when the "backing layer fractures due to a mechanical action." This is not quite accurate. Although, in some embodiments of Applicants' invention, very small particles of microcapsules becomes exposed, this is not the same as a macroscopic structure cracking due to being brittle. Rather, in all embodiments of Applicants' invention, the backing layer is flexible (as claimed), as would be clear to one of skill in the art with such language as "the free end is allowable to fall back onto and cling to the outer surface of the roll." (Specification, page 5, line 21 to page 6, line 1).

Claim 12 stands rejected over the "admitted prior art" in view of Hielman et al. and further in view of Powell et al. ('398). As with the rejection under the "admitted prior art"/Hielman et al. combination, the Examiner has failed to establish *prima facie* obviousness for several reasons. First, in order to reject claims under 35 U.S.C. §103, the Examiner must provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art, or to combine references, to arrive at Applicant's claimed invention. There must be something *in the prior art* that suggested the combination, other than the hindsight gained from knowledge that the inventor choose to combine these particular things in this particular way. Uniroyal Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988). The Examiner is also required to make specific findings on a suggestion to combine prior art references. In Re Dembiczak, 175 F.3d 994, 1000-01, 50 USPQ2d 1614, 1617-19 (Fed. Cir. 1999).

GIFFORD, KRASS, GROH, SPRINKLE, ANDERSON & CITKOWSKI, P.C. 280 N. OLD WOODWARD AVENUE, STE. 400, BIRMINGHAM, MICHIGAN 48009-5394 (248) 647-6000

In this case, there is no teaching or suggestion whatsoever from these references to form the combination suggested by the Examiner and, in fact, by stating that it would have been obvious to employ a fluorescent die in a microcapsule in a backing layer of a tape for the reasons given, only reiterates Applicants' own invention.

Secondly, both Hielman et al. and Powell et al. represent non-analogous art. In order to rely on a reference as a basis for rejection, a reference must either be in the field of Applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned. In Re Oetiker, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). In this case, since Hielman et al. is directed to a tamper-resistant closure with a layer that fractures, and Powell et al. is directed to a pressure-sensitive copy sheet, neither of these references may reasonably be construed to be within the same field of endeavor as Applicants, that being adhesive tapes such as packing tapes, and the like.

Based upon the comments, Applicants believe all claims continue to be in condition for allowance. Questions regarding this application can be directed to the undersigned attorney at the telephone/facsimile numbers provided.

Respectfully submitted,

By: _____

John G. Posa
Reg. No. 37,424
Gifford, Krass, Groh, Sprinkle,
Anderson & Citkowski, PC
280 N. Old Woodward Ave., Ste 400
Birmingham, MI 48009
(734) 913-9300 FAX (734) 913-6007

Date: Sept. 26, 2002

OIPE JC16 OCT 01 2002 PATENT & TRADEMARK OFFICE

CERTIFICATE OF MAILING (37 CFR 1.8(a))

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231.

Date: 9-26-02

Sheryl L. Hammer

Sheryl L. Hammer

GIFFORD, KRASS, GROH, SPRINKLE, ANDERSON & CITKOWSKI, P.C. 280 N. OLD WOODWARD AVENUE, STE. 400, BIRMINGHAM, MICHIGAN 48009-5394 (248) 647-6000